

REMARKS

Following entry of this amendment, claims 71-79, 81-87 and 89-102 are pending. Support for the amendments can be found, *inter alia*, at page 17, lines 6-15. No new matter is added by way of this amendment.

REJECTIONS UNDER 35 U.S.C. § 112

Claims 71-87 and 89-98 were rejected under 35 U.S.C. § 112, second paragraph, as allegedly being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Applicant has amended these claims in accordance with the Examiner's suggestions. Accordingly, withdrawal of this rejection is respectfully requested.

REJECTIONS UNDER 35 U.S.C. § 102

Claims 71-87, 90, 92, 96 and 98 were rejected under 35 U.S.C. § 102(b) as allegedly being anticipated by Bos *et al.*, *Proc. Amer. Soc. Clin. Oncol. Abstract # 1381 (1996) ["Bos"]*; as evidenced by Herbst *et al.*, *Expert Opin: Biol. Ther. 1(4):719-732 (2001) ["Herbst"]*. Applicant respectfully traverses this rejection.

Bos and *Herbst* only relate to advanced cancer. Advanced cancer tumors are not the same as refractory tumors. While Applicant agrees that some advanced cancers may be refractory, and some refractory tumors may be advanced, not all advanced cancers are refractory.

According to *Herbst*, advanced cancer means stage III or stage IV cancer. Advanced cancer is a stage of cancer in which the disease has either spread from the primary site to other parts of the body, directly or by traveling through the network of lymph glands (lymphatics) or in the bloodstream; or remains

at the primary site but, for several reasons, including extensive size and/or tissue invasion, is not readily amendable to local therapy (surgery) performed for curative intent.

The fact that a cancer is extensive or has metastasized, indicating an advanced stage of cancer, is not necessarily a sign that the tumors are refractory to traditional treatment. Patients can have advanced cancer without ever being administered a treatment for cancer. For example, a patient may not be diagnosed with cancer until it has reached stage III or IV, i.e., become advanced. A patient with a late diagnosis and advanced cancer obviously did not receive treatment for this cancer without a cancer diagnosis.

Additionally, a patient with stage III or IV cancer may have a cancer which is responsive to traditional treatment, e.g., chemotherapy and/or radiation slows down disease progression. Just because a cancer is advanced does not mean that it is completely unresponsive to traditional treatment.

The Examiner states that "[t]he American Cancer Society defines advanced cancer as a cancer that **usually** cannot be cured, and that **some people** develop advanced cancer after years of treatment." Office Action, page 5, emphasis added. However, "usually" and "some people" is not the standard for anticipation.

The Examiner seems to be making the argument that, although "advanced" cancer and "refractory" cancer are not co-extensive, it is likely that the patients of *Bos* had refractory cancer. Contrary to the Examiner's stance, the fact that a certain result or characteristic may occur or be present in the prior art is not sufficient to establish anticipation. See *In re Rijckaert*, 9 F.3d 1531, 1534 (Fed. Cir. 1993; *In re Oelrich*, 666 F.2d 578, 581-82, (CCPA 1981).

To establish anticipation by inherency, "the extrinsic evidence 'must make clear that the missing descriptive matter is

necessarily present in the thing described in the reference, and that it would be so recognized by persons of ordinary skill. Inherency, however, may not be established by probabilities or possibilities. The mere fact that a certain thing may result from a given set of circumstances is not sufficient.'" *In re Robertson*, 169 F.3d 743, 745 (Fed. Cir. 1999) (citations omitted). The Examiner has failed to provide evidence that **all** advanced cancers are refractory.

"In relying upon the theory of inherency, the examiner must provide a basis in fact and/or technical reasoning to reasonably support the determination that the allegedly inherent characteristic necessarily flows from the teachings of the applied prior art." *Ex parte Levy*, 17 USPQ2d 1461, 1464 (BPAI 1990) (emphasis in original). Here, the Examiner has clearly failed to do so, and has only made arguments that "some" of the patients of *Bos* may have had cancer which was refractory to traditional treatment.

Bos reports the results of two different studies. In one, two out of thirteen patients had "minor responses" to EGFR antibody treatment. In the second study, twelve patients with various types of cancers were treated, and those without tumor progression were treated up to twelve weeks. Five patients completed twelve weeks of treatment. There is no indication as to what kind of cancers these five patients had. Thus, *Bos* reports on the treatment of a total of 25 patients with an EGFR antibody. Out of these 25 patients, 7 showed some sort of response to the treatment.

There is no evidence that any of the 7 patients who showed a response out of 25 patients who were treated in *Bos* had cancer that was refractory to treatment with chemotherapy and/or radiation. It is possible that the advanced cancer of all 7 of these patients were due to a late diagnosis, and/or had occurred after treatment with surgery alone. It is also possible that

the patients with advanced cancer were, in fact, responsive to chemotherapy and/or radiation, but elected not to pursue this course of treatment due to the undesirable side effects and/or the likelihood that the traditional treatment would not result in a complete cure due to the advanced stage of the disease.

In addition, *Herbst* was published in 2001, after the priority date of the present application. Thus, *Herbst* cannot be relied upon for making a prior art rejection.

Bos and *Herbst* fail to teach inhibition of tumor growth in refractory tumors. Thus, the present claims are not anticipated. Accordingly, withdrawal of this rejection is respectfully requested.

REJECTIONS UNDER 35 U.S.C. § 103

Claims 71 and 89 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Bos*, as evidenced by *Herbst*, in view of Surani, U.S. Patent No. 5,545,807 ["*Surani*"]. Applicant respectfully disagrees.

As stated above, both *Bos* and *Herbst* fail to teach the treatment of refractory tumors. *Surani* teaches the production of antibodies from transgenic animals and makes no mention of refractory tumors. Thus, *Surani* does not remedy the clear deficiencies of the references above. The claims are non-obvious relative to each and every one of the cited references, taken alone or in any combination. Reconsideration and withdrawal of this ground of rejection is respectfully requested.

Claims 71 and 93-95 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Bos*, as evidenced by *Herbst*, in view of Ladner, U.S. Patent No. 5,260,203 ["*Ladner*"]. Applicant respectfully disagrees.

As stated above, both *Bos* and *Herbst* fail to teach the treatment of refractory tumors. *Ladner* teaches single chain

antibodies, but makes no mention of refractory tumors. *Ladner* does not remedy the clear deficiencies of the references above. The claims are non-obvious relative to each and every one of the cited references, taken alone or in any combination. Reconsideration and withdrawal of this ground of rejection is respectfully requested.

Claims 71 and 97 were rejected under 35 U.S.C. § 103(a) as allegedly being unpatentable over *Bos* in view of *Malecka-Panas, E. et al., Hepato-Gastroentero. 44: 435-440 (1997)* ["*Malecka-Panas*"] and *Radinsky R., European J. Cancer 31A(7/8):1091-1095, (1995)* ["*Radinsky*"]. Applicant respectfully disagrees.

As stated above, both *Bos* and *Herbst* fail to teach the treatment of refractory tumors. *Malecka-Panas* and *Radinsky* disclose the expression of EGFR in metastatic cancers. Neither *Malecka-Panas* nor *Radinsky* discuss the treatment of refractory tumors and fail to remedy the deficiencies of *Bos* and *Herbst*. The claims are non-obvious relative to each and every one of the cited references, taken alone or in any combination. Reconsideration and withdrawal of this ground of rejection is respectfully requested.

As it is believed that all of the rejections set forth in the Official Action have been fully met, favorable reconsideration and allowance are earnestly solicited.

If, however, for any reason the Examiner does not believe that such action can be taken at this time, it is respectfully requested that she telephone Applicant's attorney at (908) 654-5000 in order to overcome any additional objections which she might have.

Application No.: 09/996,954

Docket No.: IMCLON 3.0-003 PCCI

If there are any additional charges in connection with this requested amendment, the Examiner is authorized to charge Deposit Account No. 12-1095 therefor.

Dated: May 2, 2008

Respectfully submitted,

By Andrea Jo Kamage
Andrea Jo Kamage
Registration No.: 43,703
LERNER, DAVID, LITTENBERG,
KRUMHOLZ & MENTLIK, LLP
600 South Avenue West
Westfield, New Jersey 07090
(908) 654-5000
Attorney for Applicant

866609_1.DOC